

REMARKS

Claims 1 to 28 and 31 to 33 are pending, of which Claims 1, 11, 16 and 24 are independent. Claims 1, 11, and 16 are amended. Reconsideration and further examination are respectfully requested.

By way of an introduction and a non-limiting example, one or more embodiments have application in an advertising industry that serves ads via a network to a user computer, and desires to monitor the effectiveness of served ads. Any of a number of measures might be used in monitoring an ad's effectiveness, including capturing the number of times the ad is viewed by a user (often referred to as a "page view"), the number of times a user activates a link in the ad to the advertiser's web page (often referred to as a "click-through"), and the number of times a user makes a purchase after activating a link in the ad (often referred to as an "acquisition").

In accordance with a conventional approach described in the present application, an "ad-serving entity" receives advertising content from advertisers or agencies, and uses a staff of programmers to incorporate received ad content into ad code before the ad content is served to a user computer. This process must be repeated any time the ad content and/or ad code changes. Such work is labor intensive and results in both decreased profits for the entities serving the ads and, to the extent the cost is not completely absorbed by the entity serving the ad, increased advertising costs to the advertiser and/or agency.

In accordance with aspects of the claims, by way of non-limiting example, an integrated ad file, which is served to a computer to provide the ad, is created by combining an ad input file, which identifies ad content, with a conduit file, which comprises computer code to track the ad. With this arrangement, an advertiser may provide the content to any number of different ad-serving entities without concerning itself with the ad tracking methodologies that are to be used with the content. Similarly, a tracking methodology can be selected and implemented independent of the ad content. On one hand, advertisers may modify the ad content without implicating changes to the tracking code, and on the other hand, modifications can be made to the tracking methodology and code without implicating changes to the ad content.

By way of a non-limiting example and with reference to Figure 5 of the present application, in accordance with one or more embodiments, an ad input file, e.g., ad input file

504, is combined with a conduit file, e.g., conduit file 506, using a merge tool 502 to automatically create an integrated ad file prior to serving the integrated ad file from a computer. The merge tool 502 automatically creates integrated ad file 204 using the ad input file 504 and the conduit file 506, wherein the ad input file 204 identifies the content of the ad and the conduit file comprises computer code to identify tracking data for the ad. Reference is also respectfully made to Figures 6 to 9 of the present application. Figure 6 illustrates a portion of an exemplary ad input file 502, and Figure 8 provides an example of an integrated ad file 204 portion that includes the contents of the exemplary ad input file 502. As is described in paragraph [0028] of the present application, the ad input file includes the contents of the ad. Figure 7 illustrates a portion of an exemplary conduit file 506, and Figure 9 illustrates a portion of the integrated ad file 204 portion that includes the exemplary conduit file 506.

The Office Action rejects Claims 1-10 under 35 U.S.C. § 112, first paragraph, and contends that the specification does not disclose a conduit file that comprises computer code to provide the ad and to identify tracking data for the ad. Without conceding the correctness of this rejection, and solely to advance prosecution of the pending claims, Applicant amends independent claim 1. Reconsideration and withdrawal of the § 112, first paragraph rejection are respectfully requested.

Claims 1, 4, 7-10 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by a white paper by Solbright titled “The Inside Edge on Rich Media Partnership Series” (referred to herein as Solbright), and Claims 2, 3, 5, 6, 11-28, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Solbright in view of Official Notice taken by the Examiner. Reconsideration and withdrawal of the rejections are respectfully requested for at least the reasons set forth below.

Claim 1 recites a method for providing an ad via a computer network. According to the method, an ad input file is combined with a conduit file using a merge tool to automatically create an integrated ad file prior to serving the integrated ad file from a computer. The ad input file identifies the contents of the ad and the conduit file contains computer code for identifying tracking data for the ad. The integrated ad file contains both the ad input file and the conduit file and is served from a computer to provide the ad.

Solbright fails to teach, suggest or disclose “combining an ad input file with a conduit file using a merge tool to automatically create an integrated ad file containing both the ad input file and the conduit file contents,” as claimed in amended independent claim 1. The Office Action refers to pages 17-19 of Solbright as teaching this claim feature. These pages of Solbright, however, do not teach this feature. On page 17, Solbright discloses:

To help ease the burden of this process, the MFAA advises developers to create an editable HTML wrapper for the ad that uses <OBJECT> and <EMBED> tags to pass through the appropriate parameter for the tracking string to the getURL action command within the compiled SWF file.

Page 18 of Solbright provides a list of Solbright’s recommended process for inserting a tracking string:

1. Create a Macromedia Flash ad with at least one button element.
2. For the button that will be used to track the clickthrough data, assign a simple getURL(clickTAG) action.
3. Create an alternate GIF version of the ad.
4. Create an HTML wrapper file that uses the <OBJECT> and <EMBED> tags to pass the appropriate parameters for the tracking string to the ad. Each publisher will need to modify this file to insert their own, unique tracking code. This file should also have the appropriate sniffer code to detect the presence of the Macromedia Flash Player, and to display the alternate GIF ad if necessary.

Thus, Solbright discloses two distinct files - an advertisement file (e.g., SWF file) and an editable HTML wrapper file for the advertisement file. The wrapper file communicates with the advertisement file by passing parameters to the advertisement file via <OBJECT> and <EMBED> tags, but Solbright does not disclose combining the two files using a merge tool into a single integrated ad file, as claimed in amended independent claim 1. Solbright does not disclose any type of combination of its advertisement file with its tracking code and instead teaches a wrapper file being used in addition to an advertisement file. There is no integrated ad file in Solbright, and further there is no merge tool to combine an ad input file with a conduit file into an integrated ad file.

For at least the foregoing reasons, Claim 1 is believed to be patentable over Solbright, alone or in combination with any other art of record. In addition, Claims 2-10 and 31-33, which depend from Claim 1, are also believed to be patentable for at least the same reasons.

Furthermore and with respect to Claim 2, a modified integrated ad file is created by combining a received modified ad input file representing a change to the content of an ad with the conduit file. Claim 3 recites steps of receiving a modified conduit file representing a change to the tracking data, combining the modified conduit file with the ad input file to create a modified integrated ad file, and serving the modified integrated ad file, to provide an ad having the changed tracking data. The Office Action states that “it would have been obvious ... that the designer or programmers of Solbright would accept a new or modified information or content from the source and insert the same or different tracking information.” (Office Action, page 5). Solbright does not, however, teach or suggest combining a modified ad input file with a conduit file to create a modified integrated ad file. Further, Solbright does not teach or suggest combining a modified conduit file with an ad input file to create a modified integrated ad file. As a result, dependent claims 2 and 3 are allowable over Solbright.

With respect to claims 5 and 6, the Office Action states that Solbright “does not explicitly teaches (sic) the input file includes (sic) an empty movie object and inserting the conduit file in the empty movie object; wherein the empty movie clip is given a predefined name and searching for the predefined name.” (Office Action, page 5). The Office Action continues by stating that:

However official notice is taken that well known in the art of movie clip create empty movie clip and to assign a predetermined name. It is well known to create an empty movie clip using Macromedia Flash, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the empty clip as a placeholder for external files such as the tracking data, if the ad is a movie clip.

Further, with respect to claims 11, 12, 15-21, and 24-27, the Office Action states that “official notice is taken that [it] is old and well known in the art of programming to create empty movie clip[s] using Macromedia Flash.” (Office Action, page 6).

To the extent that the Examiner is relying on “Officially Noticed” facts, the Applicant hereby traverses such Official Notice based at least on the above discussion, and specifically requests the Examiner to provide documentary evidence of any such “Officially Noticed” facts should the Examiner maintain the rejection. Applicant submits that it was not well known to

create an empty movie clip and insert a conduit file into the empty movie clip if the empty movie clip was an advertisement.

The Applicant's previous response requested the Examiner to provide the necessary support for the Official Notice taken by the Examiner. While the Examiner maintained the rejection and continues to rely on Official Notice in the current Office Action, the Examiner did not provide the necessary support requested by the Applicant. The burden remains with the Examiner to provide the requisite support for the Examiner's grounds of rejection. The Applicant renews its request that the Examiner provide the requisite support for the Official Notice, should the Examiner continue to rely on Officially Noticed facts. For at least the reasons provided below, however, the Applicant submits that the grounds for rejection should be withdrawn.

With reference to the Officially Noticed facts, Applicant's current and previous responses include a request that the Examiner provide evidence to substantiate the Officially Noticed facts. The Examiner has refused to provide the requested substantiation based on a conclusion by the Examiner that Applicant's request was insufficient. It is clear from MPEP § 2144.03 and the caselaw¹ provided therein that the Applicant's request/response was more than sufficient. Furthermore and as is also made clear in MPEP § 2144.03, Official Notice is only appropriate in a limited number of circumstances and should only be taken where the facts asserted to be well-known or common knowledge are capable of instant and unquestionable demonstration as being well-known or common knowledge, which is not the case here.

As is made clear from MPEP § 2144.03 and caselaw, Applicant's response was more than sufficient to challenge the unsubstantiated assertions made in the previous Office Action, and such documentary evidence of the facts Officially Noticed should have been provided with the current Office Action. The Applicant renews the traversal of the Official Notice taken in the previous and current Office Actions, and further renews the request for the documentary evidence of the facts Officially Noticed in the § 103(a) rejection of Claims 2, 3, 5, 6, 11-28, 31 and 32, should the Examiner maintain the § 103(a) rejection of these claims.

¹ For example and in view of the position taken by the court in *In Re Chevenard*, 139 F.2d at 711, 60 USPQ at 239 (CCPA 1943), something more than a total absence of some demand is sufficient, and that such a response would be more than sufficient to prompt the examiner to produce authority for her assertions in response.

Referring to Claim 5, the ad input file includes an empty movie clip object such that the combining of an ad input file with a conduit file to create an integrated ad file recited in Claim 1 includes inserting the conduit file into the empty movie clip object. Claim 6 depends from Claim 5, and further recites that the empty movie clip object is given a predefined name and combining the ad input file and conduit file includes searching the ad input file for the predefined name and inserting the conduit file into the empty movie clip with the predefined name.

In rejecting Claims 5 and 6, the Office Action concedes that Solbright fails to teach or suggest an ad input file that includes an empty movie clip object, fails to teach or suggest inserting a conduit file in the empty movie clip object, fails to teach or suggest an empty movie clip object having a predefined name, and further fails to teach or suggest searching the ad input file for the predefined name of the empty movie clip object. The Office Action then assumes “Officially Noticed” facts, and alleges that such facts suggest each and every one of the elements of Claims 5 and 6 not disclosed or taught by Solbright. In view of the complete absence of any teaching or suggestion in Solbright with respect to multiple elements of Claims 5 and 6, as conceded in the Office Action, the Applicant traverses the Official Notice taken in the Office Action. Should the Examiner maintain the rejection, the Applicant respectfully requests that the Examiner provide evidentiary support for the “Officially Noticed” facts, and requests that the Examiner provide documentary evidence with respect to the claimed empty movie clip object of the ad input file into which the claimed conduit file is inserted, combining an ad input file and a conduit file by inserting the conduit file into the empty movie clip of the ad input file, searching the ad input file for a predefined name of the empty movie clip of the ad input file, and combining an ad input file to create an integrated ad file by inserting the conduit file into the empty movie clip having the predefined name in the ad input file.

With respect to Claims 7-10, the Office Action alleges that pages 18-20 of Solbright teach an ad input file specifying one or more button actions, each of which has an exit code (Claim 7); a conduit file (Claim 8), or JavaScript file (Claim 9), which includes code that determines whether an ad opens in a parent window or a new window using a variable included in HTML code used to serve the integrated ad file; and tracking an ad using code in the claimed conduit file and a tracking identifier included in HTML code serving the claimed integrated ad file (Claim 10). A review of the portion of Solbright generally referenced in the Office Action

fails to uncover any portion of Solbright that discloses or suggests at least the above-identified elements of Claims 7-10. Should the Examiner maintain the § 102(b) rejection of Claims 7-10 over Solbright, the Examiner is respectfully requested to identify the particular portions and precise elements of Solbright that the Examiner considers teaches each and every one of the elements recited in Claims 7-10.

With regard to Claims 11, 12, 15-21, and 24-27, the Office Action contends (commencing at page 5) that:

Solbright teaches identifying a first file (flash ad); identifying a second file (tracking information); wherein the first file specifies ad content code and the second file contains ad-tracking code; creating an ad file including computer code for providing the ad; wherein the first file specifies ad content code and the second file contains an ad-tracking code; html code loading ad file (third file); third file including one or more buttons; creating the [sic] (see pp 17-20). Solbright does not explicitly teach identifying a placeholder (an empty movie clip) in the first file and electronically inserting the second file in the placeholder to create an ad file. However official notice is taken that [it] is old and well known in the art of programming to create an empty movie clip using Macromedia Flash. Macromedia Flash is used to create an empty movie clip, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to create an empty movie clip, in rich media, as a placeholder for external files such as the tracking data to be inserted into it, if the ad is a movie clip.

With regard to the Official Notice taken in the Office Action, the Applicant respectfully submits, as is clearly set forth in MPEP § 2144.03, that Official Notice is only appropriate in a limited number of circumstances and should only be taken where the facts are capable of instant and unquestionable demonstration as being well known or common knowledge. This is not the case here. The Applicant traverses the Official Notice taken in the Office Action. Should the Examiner maintain her rejection of the claims based on Officially Noticed facts, the Applicant respectfully requests that the Examiner provide documentary support for each fact Officially Noticed. The requested documentary support is particularly important in view of the Examiner's own admission in her grounds for rejecting Claims 2, 3, 5, 6, 11-28, 31 and 32, in which the

Examiner concedes that the only documentary evidence of record relied on to make the § 103(a) rejection of these claims fails to teach, suggest or disclose multiple elements of these claims.

With regard to independent Claims 11, 16 and 24, the Examiner concedes that Solbright fails to teach or suggest a placeholder in a file, identifying a placeholder in a first file and electronically inserting a file in the placeholder to create an ad file. Therefore, Solbright's approach cannot teach, suggest or disclose the methods of Claim 11, 16 or 24. The Examiner takes official notice of creating an empty movie clip using Macromedia Flash so that external files can be loaded into it. The Office Action then states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to create an empty movie clip, in rich media, as a placeholder for external files such as the tracking (sic) data to be inserted in it, if the ad is a movie clip." (Office Action, page 6). As stated above, Applicant traverses the Official Notice taken by the Examiner in rejecting Claims 11, 12, 15-21 and 24-27. Applicant submits that the features recited in claims 11, 16, and 24 are not obvious. As a result, independent claims 11, 16, and 24, and the claims that depend from claims 11, 16, and 24, are allowable over Solbright, alone or in combination with any other art of record.

In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney. Alternatively, since it is believed that the claims of the present application are in condition for allowance, the Examiner is respectfully requested to issue a Notice of Allowance at the Examiner's earliest convenience.

The Applicant's attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address given below, which is the address associated with Customer Number 76058.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-1561. Please ensure that the Attorney Docket Number is referenced when charging any payments or credits for this case.

Respectfully submitted,

James J. DiCarlo
Reg. No. 36,120

Date: February 6, 2009

Customer Number 76058
GREENBERG TRAURIG, LLP
Met Life Building
200 Park Avenue, 20th Floor
New York, New York 10166
Phone: (212) 801-9200
Fax: (212) 801-6400